

REMARKS

Claims 1-53 were pending. Claims 1-4, 13-19, 35-42 and 46-53 were rejected while claims 5-12, 20-34 and 43-45 were objected to. Claims 1, 2, 5, 16, 17, 38, 41-44, 51 and 52 have been amended by the above amendment while claims 40, 45, and 53 have been canceled. Claims 54-59 are new. Therefore, claims 1-39, 41-44, 46-52, 54-59 are currently pending. The applicant requests further examination and reconsideration in view of the amendments made above and the remarks set forth below.

The specification has been amended to correct a minor informality. The word "a" has been replaced by the word "an" in three places. Claims 1, 5, and 16 have been amended to correct minor informalities. No new matter has been added.

Information Disclosure Statement:

The Information Disclosure Statement filed on December 27, 2004 does not appear to have been considered by the Examiner. A copy of the Information Disclosure Statement and the postcard receipt showing that the Information Disclosure Statement was received in the mailroom of the U.S. Patent and Trademark Office on January 3, 2005 are enclosed. Therefore, the applicants respectfully request consideration of the Information Disclosure Statement filed on December 27, 2004.

Rejections under 35 U.S.C. § 112:

Claim 53 was rejected as being indefinite. Claim 53 has been canceled.

Rejections under 35 U.S.C. § 102(b):

The examiner has rejected claims 51-53 under 35 U.S.C. § 102(b) as being anticipated by International Application WO 99/56942 by Conway (hereinafter referred to as "Conway"). In particular, the examiner stated that Conway discloses an eyeglass assembly comprising an eyeglass frame having lens receptacles and a pliable coating coupled to the eyeglass frame including a brow portion, the brow portion having side portions extending above the lens receptacles and the pliable coating having extensions coupled to the brow portion and extending downwardly along both sides of a wearer's nose.

The invention described by Conway is an injection molded eyewear frame. Conway, Abstract. The eyewear frame is constructed of rigid plastic across substantially the entire front-facing surface and of a soft plastic across substantially the entire rearward-facing surface. Conway, page 2, lines 19-20. It can be seen from the figures of Conway that the soft plastic entirely encircles both lenses on the rearward-facing surface.

Claim 51 has been amended to recite that the pliable coating includes a brow portion that terminates at extremities above the lens receptacles and extensions that terminate at extremities along both sides of the wearer's nose. Support for this amendment can be found in the specification at least on page 2, lines 19-22, page 6, lines 8-11, and figures 1, 2, 3A and 4. No new matter has been added.

Therefore, claim 51 as amended requires that the pliable coating is coupled to specific portions of the eyeglass frame and does not entirely surround both lenses. In contrast, the soft plastic of Conway is used across substantially the entire rearward-facing surface and entirely encircles both lenses. Claim 51 is allowable over Conway because Conway does not disclose eyewear as recited in amended claim 51.

Claim 52 has been amended to incorporate features described in dependent claim 53. It has also been amended in a similar manner to claim 51. Claim 52 is allowable for at least the same reasons as claim 51.

Rejections under 35 U.S.C. § 103(a):

The examiner has rejected claims 1-4, 13-19, 35-42, 46-50 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,793,336 issued to Min (hereinafter referred to as "Min") in view of Conway. In particular, the examiner stated that Min discloses an eyeglass assembly comprising an eyeglass frame and a rib and that the rib has a pliable pad on at least some of the surface. As stated by the examiner, Min does not suggest that the pliable pad is coated on the rib. The examiner suggests that Conway discloses a technique to coat a pliable pad on an eyeglass frame for providing a soft comfortable fit while also providing a cushioning component between the user's face and the eyeglass frame. The examiner stated that it would have been obvious to modify Min in light of Conway to provide a pliable coating on the frame for the same purpose as disclosed by Min and Conway.

The applicant respectfully traverses the rejection. Min describes a ventilated glasses system having an eyeglass frame and a removable pad. Min, column 3, lines 28-30. An inner frame is removably attached to the eyeglass frame by detents. Min, column 3, lines 46-50. The pad is positioned on the back surface of the inner frame and significantly reduces the wind from blowing on a person's eyes while wearing the glasses. Min, column 4, lines 3-6. The pad is made from foam or some other soft pliable materials that are gentle and comfortable on a person's skin and can compress against a person's face, thus conforming to the shape of the person's face. Min, column 4, lines 5-11. The thickness of the pad may be up to 1 1/2 inches. Min, column 4, lines 12-14. The function of the pad and a stated object of Min's invention is to minimize the airflow impacting the eyes from around the perimeter of the glasses. Min, column 1, lines 51-52 and column 4, lines 17-19. Thus, a cavity with a partial air seal is formed by the pad and the eyewear against person's face. Min, column 2, lines 19-22.

In contrast to Min, the invention described by Conway does not use a foam material. Instead, Conway describes a soft plastic with a hardness rating of 55 to 73 Shore A. Conway, page 5, lines 12-15. Moreover, Conway notes that the prior art includes plastic eyewear frames with foam material affixed to the rearward-facing surface of the front frame. Conway, page 1, line 31 to page 2, line 9. The invention described by Conway does not use foam; instead Conway discloses eyewear made with a soft plastic. The soft plastic described by Conway would not be thick enough or soft enough to perform the same functions that the pad described by Min performs. In particular, the soft plastic would not conform to the face of the wearer, and would not form an airflow reducing seal.

The examiner asserted that the pliable coating on the frame serves the same purpose for Min and Conway. The applicants respectfully disagree with the examiner's assertion. The purpose of Min's pliable pad is to significantly reduce the wind from blowing on a person's eyes while wearing the glasses. Min, column 4, lines 3-5. In contrast, the purpose of Conway's soft plastic is to provide a cushioning component between the frame and user's face. Therefore, the soft plastic described by Conway would fail to achieve the object of Min's invention which is to reduce the wind blowing on a person's eyes. As noted in the MPEP § 2143.02 Rev. 2:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

The modification of Min in light of Conway as proposed by the examiner would render Min unsatisfactory. This is because such a modification to Min would no longer be able to perform Min's intended purpose of reducing the air flow around the perimeter of the glasses. Therefore, there could be no suggestion or motivation to make the proposed modification. For at least this reason, independent claims 1 and 16 are allowable. Dependent claims 2-15 and 17-37 are allowable at least because they are dependent from allowable base claims.

Claim 2 and 17 recite eyewear wherein a rib is affixed to an eyeglass frame by at least one fastener and at least one attachment means being integral to the rib and the eyeglass frame. Dependent claims 2 and 17 have been amended to clarify the scope of the term "fastener." Particularly, the fastener refers to an item separate from the eyeglass frame and the rib, and which passes through an aperture of either the rib or the eyeglass frame, and is secured to either the rib or the eyeglass frame. Support for this amendment can be found at least on page 5, lines 15-18, and page 6, lines 20-25 of the applicants' specification. No new matter has been added. Neither Min nor Conway suggest or disclose a rib that is affixed to an eyeglass frame by both a separate fastener and at least one integral attachment means. Therefore, this is another reason why claims 2 and 17 are allowable.

Independent claim 38 has been amended to recite that the rib is affixed to an eyeglass frame by a fastener and at least one tab. The fastener is a separate item from the eyeglass frame, passes through an aperture in either the molded rib or the eyeglass frame, and is secured to the eyeglass frame or the rib. The attachment means is integral to the rib or the eyeglass frame. Neither Min nor Conway suggest or disclose a rib that is affixed to an eyeglass frame by both a fastener and an attachment means integral to the rib and the eyeglass frame. Therefore, for at least this reason claim 38 is allowable.

Dependent claims 41-43 have been amended to be dependent from claim 38. Dependent claims 39, 41-44 and 46-50 are allowable at least because they are dependent from allowable base claim 38.

New Claims

New independent claim 54 recites limitations which are substantially similar to some of the limitations recited in claims 1, 10 and 12. New dependent claim 55 recites limitations which are substantially similar to the limitations recited in claim 4. New dependent claim 56 recites limitations which are substantially similar to some of the limitations recited in claim 3. No new matter has been added.

Claim 54 is allowable at least because neither Min nor Conway, separately or in combination, suggest or disclose an eyeglass assembly comprising a rib and an eyeglass frame wherein the rib includes a brow portion and extensions with tabs affixing the rib to the frame and positioned near the ends of the extensions and the ends of the brow portion. In particular, the cited art does not disclose a rib with ends, nor does it disclose tabs located near the ends of such extensions that affix the rib to the frame. Claims 55 and 56 are allowable at least because they are dependent from an allowable base claim.

New independent Claim 57 recites limitations which are substantially similar to some of the limitations recited in claims 1 and 6. New dependent claim 58 recites limitations which are substantially similar to the limitations recited in claim 16. No new matter has been added.

Claim 57 recites an eyeglass assembly comprising an eyeglass frame and a rib. The rib is coupled to eyeglass frame by a plurality of tabs. At least one air vent is positioned between a pair of tabs. Min and Conway, separately or in combination, do not suggest or describe eyewear with air vents positioned between tabs which couple an eyeglass frame to a rib. For at least this reason claim 57 is allowable. Claim 58 is allowable at least because it is dependent from an allowable base claim.

New dependent claim 59 recites a limitation to claim 1 in which a tab receptacle accommodates a tab causing a distortion when fitted together. Support for this can be found in the applicants' specification at least at page 5, lines 21-24. No new matter has been added. Claim 59 is allowable at least because neither Conway nor Min, taken separately or in combination, suggest or disclose this limitation. Furthermore, Min teaches away from this limitation because the inner frame described by Min is removable and, thus, the distortion recited in claim 59 would interfere with this feature.

In view of the above, the Applicant respectfully submits that all of the pending claims are now allowable. Allowance at an early date would be greatly appreciated. Should any issues remain, the examiner is encouraged to telephone the undersigned at (408) 293-9000 to discuss the same so that any outstanding issues may be expeditiously resolved.

Law Offices of Derek J. Westberg

Dated: May 20, 2005

A handwritten signature in black ink, appearing to read "Derek J. Westberg", is written over a horizontal line.

Derek J. WESTBERG (Reg. No. 40,872)